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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,931	12/03/2003	Chiyoko Matsumi	MTS-3583US	4481
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RATNERPRESTIA			EXAMINER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/725,931

**Applicant(s)**

MATSUMI ET AL.

**Examiner**

Hung Q. Dang

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/28/2009 has been entered.

### ***Response to Arguments***

Applicant's arguments filed 04/23/2008 have been fully considered but they are not persuasive.

On pages 5-6, Applicant argues that Ando does not disclose the feature of "wherein a data storage format of said parameter information file is such that all parameter information in said parameter information file associated with one data format is stored sequential to all parameter information in said parameter information file associated with another data format by using a classification according to said data formats."

In response, Examiner respectfully disagrees. First of all, as shown in Fig. 24, in the subdirectory DVD\_RTR DIRECTORY, there are files of different formats. Let's take at least the file containing movie video object RTR\_MOV.VRO and the file containing still picture-added audio object RTR\_STA.VRO to show an example of how their all parameter information, which is interpreted as the FID for each file (see column 18,

lines 1-9 and Fig. 15 for detailed description), are stored. The storing of these FIDs (corresponding to all parameter information of a corresponding file) are shown at least in Fig. 13A and Fig. 14. Fig. 14 shows a case where there is only one file stored in the subdirectory 402 but still helps in understanding of how the FIDs stored in case of a plurality of files being stored with assistance of Fig. 13A.

As shown in Fig. 13A, the entry of "SUBDIRECTORY F FE (AD(113)) 482" would corresponds to the field 405, which is "FILE DATA INFORMATION RECORDED POSITION UNDER SUBDIRECTORY" of Fig. 14. This entry tells where to locate the FIDs of the files stored in this subdirectory using the information in AD(113). In this case, there are two files H and I being stored in this subdirectory.

Since it says the FIDs are stored in location 113. It goes there to obtain the FIDs. It is worth noting that, since the FID is stored in a contiguous piece as shown in Fig. 15 and all of parameter information of a file is stored in this FID, the FID of the file H and the FID of the file I are stored in their complete format as shown in Fig. 15 and stored sequential to each other. In other words, there are two FIDs stored in location 113. One is for the file H and one is for the file I.

Further, the field 423 of "INFORMATION CONTROL BLOCK INDICATING THE RECORDED POSITION OF CORRESPONDING FE" shown in Fig. 15 is used to store the location where the FE for the corresponding file is stored (this FE would correspond to the field 407 of "RECORDED POSITION IN FILE DATA" shown in Fig. 14, which again corresponds either the entry 114 (FE for the file H) or the entry 118 (FE of the file I) shown in Fig. 13A. If it looks into the FID of the file H, then it will get the location of

114 where the FE for the file H is stored. Otherwise, if it looks into the FID of the file I, then it will get the location of 118 where the FE of the file I is stored.

The locations 114 and 118 are where the data file holding positions information are recorded. Specifically, the FE of the file H provides the information about positions where the file data of the file H is recorded, i.e. from locations 115-117 and the FE of the file I provide information about the positions where the file data of the file I is recorded.

Therefore, if the files with different file formats as shown in Fig. 24 are implemented according to the teachings discussed above, Ando clearly discloses the feature of "wherein a data storage format of said parameter information file is such that all parameter information in said parameter information file associated with one data format is stored sequential to all parameter information in said parameter information file associated with another data format by using a classification according to said data formats."

On pages 6-7, Applicant argues that, "Cazier's number scheme is based on the chronological order in which images are taken by a camera. Cazier does not disclose or suggest giving the ID based on the order in which the parameter information is stored in the parameter information file."

In response, Examiner respectfully submits that giving each object a unique ID by using an order in which the object is created in column 1, lines 15-21. When an object is created and stored, its parameter information is also created. Therefore, both object file and its associated parameter information are created in such an order of

generation. As such, the limitation of "the unique data file ID is given by using order in which said parameter information file stores said parameter information" is met.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 6 is rejected under 35 U.S.C. 101 the claimed invention is directed to non-statutory subject matter. .**

Claim 6 is rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

**The USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:**

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101.

.... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

**Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.**

Claim 7 recites “a computer-readable medium”. However, the recited “computer-readable medium” could be reasonably interpreted as encompassing statutory media such as a “ROM”, “RAM”, “EPROM”, “CD-ROM”, etc, as well as non-statutory subject matter such as a magnetic, optical, electromagnetic, infrared, ... or propagation medium.

A “magnetic, optical, electromagnetic, infrared, ... or propagation medium” is neither a process nor a product, (i.e., a tangible “thing”) and therefore does not fall

within one of the four statutory classes of § 101. Rather, a "magnetic, optical, electromagnetic, infrared, ... or propagation medium" is a form of energy, in the absence of any physical structure or tangible material.

The Examiner suggests amending the claim to recite the "computer-readable medium" as "computer-readable non-transitory storage medium" to include tangible computer readable media, while at the same time excluding the intangible media such as signals, carrier waves, etc. Any amendment to the claim should be commensurate with its corresponding disclosure.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al. (US Patent 6,341,196 – hereinafter Ando) and Cazier (US Patent 7,143,114).**

Regarding claim 1, Ando discloses a recording and reproducing system comprising (*column 4, lines 59-67*): a record medium holding a plurality of data files of storing predetermined data, said data files being classified according to their data formats (*Figs. 18; Fig. 15; column 22, lines 8-14*) and parameter information used for reproducing said predetermined data (*column 17, lines 16-29; column 19, lines 18-54*); data file holding position information file recording means of recording data file holding



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position information, which indicates a position where said data file is held in a data file holding position information file held on said record medium (*column 22, line 8 – column 23, line 10; Figs. 18; Figs. 19; Fig. 13A; Fig. 14; column 18, lines 9-15*); parameter information file recording means of recording said parameter information in a parameter information file held on said record medium (*column 17, lines 16-29; Fig. 14; Fig. 15*); and data reproducing means of reproducing said predetermined data stored by said data file by using said data file holding position information and said parameter information (*column 19, lines 18-54*), wherein a data storage format of said parameter information file is such that all parameter information in said parameter information file associated with one data format being stored sequential to all parameter information in said parameter information file associated with another data format by using a classification according to said data formats (*column 17, lines 16-29; Fig. 14; Fig. 15; Fig. 24; also see "Response to Arguments" above*). Further, Ando also discloses each of said data file is given unique data file ID (*column 18, lines 7; Fig. 16*); and the parameter information of the data files are stored in an order (*for example, parameter information of data file C (entry 106) go before those for data files H (entry 114) and I (entry 118) respectively as shown in Fig. 13A*), and said data file holding position information is recorded in said data file holding position information file by using said unique data file ID which are given (*column 18, lines 1-15; Fig. 13A; Fig. 16*).

However, Ando does not disclose the unique data file ID is given by using order in which said parameter information file stores said parameter information.

Cazier discloses giving each object a unique ID by using an order in which the object is created (*column 1, lines 15-21*).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the step of giving a unique ID using order as described by Cazier into the recording apparatus disclosed by Ando so that each ID is automatically generated in order for reasons of simple implementation. The incorporated feature would eliminate the need for a complicated naming algorithm in creating the management records; thus, should be preferred.

Regarding claim 2, Ando also discloses said data file holding position information file stores said file holding position information with respect to said plurality of data files are held respectively (*Fig. 13A*).

Claim 6 is rejected for the same reason as discussed in claim 1 above.

Claim 7 is rejected for the same reason as discussed in claim 1 above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Q. Dang whose telephone number is (571)270-1116. The examiner can normally be reached on IFT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hung Q Dang/  
Examiner, Art Unit 2621

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621